

Application No. 10/700,306
Amendment A dated March 20, 2006
Reply to Office Action mailed October 20, 2005

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed October 20, 2005. Claim 3 is cancelled, claims 1, 3, 12, 14, 16, 21, and 22 are amended, and new claims 26-29 are added. Claims 1-12 and 14-29 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. CLAIM OBJECTIONS

The Examiner objects to claims 1 and 21 for minor informalities. In response, claims 1 and 21 are amended as suggested by the Examiner. As such, the Applicant respectfully requests that the objections be withdrawn.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1, 2, 11, and 16 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* (U.S. Patent No. 4,998,256). Applicants traverse the Examiner's rejection for obviousness on the grounds that the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims.

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According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

(Emphasis added).

Referring to Figure 5 of *Ohshima* reproduced below, a semiconductor laser module is shown. The module includes a semiconductor laser, an output fiber 34, a collimating lens 35, a beam splitter 36, a first photo-detector 38 used as a power monitor output, a Fabry-Perot resonator 39, an optical lens 40, and a second Photodetector 41. Col. 4, ll. 16-38.

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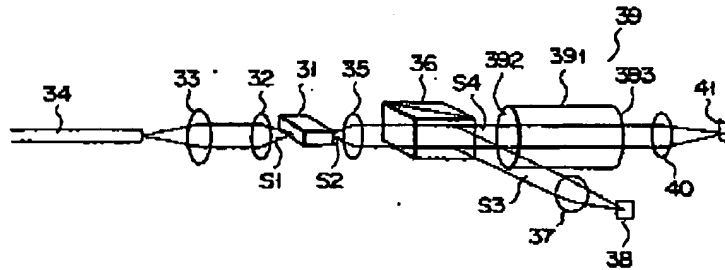


FIG. 5

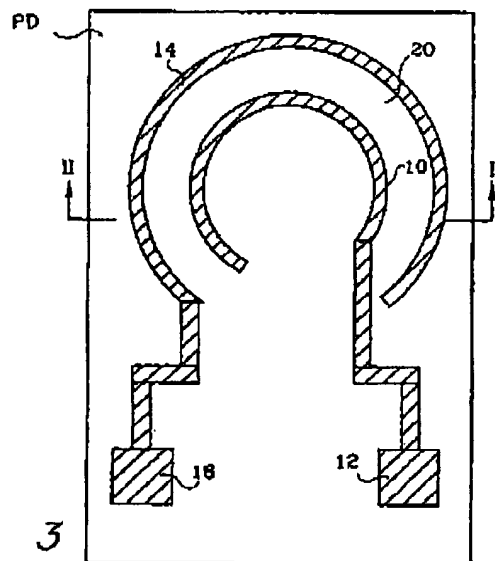
The Examiner has not shown, however, that *Ohshima* further discloses “a common substrate, wherein the surface, the collimating lens, the filter layer, the first photosensitive area, and the second photosensitive area are supported by the common substrate” as set forth in amended claims 1 and 16. Therefore, Applicants submit that a *prima facie* case is not set forth for obviousness and respectfully requests that the rejection be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claims 2 and 11 depend from claim 1. Therefore, the Applicant respectfully requests that the rejection of claims 2 and 11 be withdrawn at least for the same reasons as claim 1.

The Examiner rejects claim 3 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Cox* (U.S. Patent No. 5,812,581). Applicants traverse the Examiner’s rejection for obviousness on the grounds that the Examiner has not established that the references – either individually or in combination – teach or suggest each and every element of the rejected claims.

As discussed above, it is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added). *Cox* discloses a lens for a semiconductive device with a laser and a photodetector in a common container. See Title. Figure 3 reproduced below is a top view illustrating two separate conductive members 10 and 14 on the top surface of the photodetector layer PD. The conductors provide two generally concentric partial circles upon a portion of the photodetective surface. Col. 7, lines 20-31. Thus, conductors 10 and 14 in *Cox* are conductors, not photosensitive areas as recited in claim 3.

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Claim 3, on the other hand recites the element “the first photosensitive area and the second photosensitive area are arranged concentrically such that the second photosensitive area at least partially surrounds the first photosensitive area” (Emphasis added). Thus, the Office Action has not set forth a proper *prima facie* case of obviousness because the Office Action has not shown that the combination of *Ohshima* and *Cox* teaches or suggests each and every element of the Applicant’s claimed invention. As such, the Applicant respectfully requests that the rejection of claim 3 be withdrawn.

The Examiner rejects claim 5 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Zheng* (U.S. Patent No. 5,963,686). As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claim 5 depends from claim 1. Therefore, the Applicant respectfully requests that the rejection of claim 5 be withdrawn at least for the same reasons as claim 1.

The Examiner rejects claims 7-10 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Bruun-Larsen* (U.S. Patent Application Pub. US 20020141463 A1). Claims 7-10 depend from claim 1. As discussed above, if an independent claim is nonobvious under 35

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U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicant respectfully requests that the rejection of claims 7-10 be withdrawn at least for the same reasons as claim 1 from which they depend.

The Examiner rejects claim 12 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Munks* (U.S. Patent No. 6,587,214). Applicants traverse the Examiner's rejection for obviousness on the grounds that the Examiner has not established that the references – either individually or in combination – teach or suggest each and every element of the rejected claims.

According to the Office Action, “*Munks* teaches a device that determines the power of the light emitted by a laser diode from a sum of the detection response of two photosensitive areas (Col. 3, lines 6-15).” However, column 3, lines 6-15 of *Munks* teach the following:

A second detector is positioned in the path of the optical beam. The second detector generates a second electrical signal that is proportional to an optical power of the filtered optical beam corresponding to the channel. A signal processor receives the first and second electrical signals. The signal processor generates at least one signal that corresponds to the wavelength and power of the optical beam transmitting in the communication system. This signal can be used to control the wavelength and power of the multi-wavelength laser.

The Applicant is unable to locate in this portion of *Munks* where a sum is calculated as purported by the Examiner. Rather, *Munks* merely talks about generating “at least one signal that corresponds to the wavelength and power of the optical beam” but *Munks* does not teach in this section how the at least one signal is generated. However, *Munks* specifies in the Detailed Description that the at least one signal is generated using a ratio of the optical power detected by a first detector to the optical power detected by the second detector. See col. 4, ll. 25-32; col. 5, ll. 13-30; col. 5, ll. 47-52; col. 6, ll. 18-22; col. 6, ll. 59-63; col. 7, ll. 31-37; col. 7, ll. 49-55; col. 8, ll. 17-19; col. 8, ll. 62-64; and col. 9, ll. 58-60. The “ratio” as disclosed in *Munks* is not the same as a “sum” as set forth in claim 12. Thus, a *prima facie* case of obviousness has not been set forth and the Applicant respectfully requests that the rejection of claim 12 be withdrawn.

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The Examiner rejects claim 13 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Kirkby* (U.S. Patent No. 4,583,227). Claim 13 is canceled; therefore the rejection of claim 13 is moot.

The Examiner rejects claims 6, 17, and 18 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Nolan* (U.S. Patent No. 3,725,817). As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claims 6, 17, and 18 depend from claims 1 or 16. Therefore, the Applicant respectfully requests that the rejection of claims 6, 17, and 18 be withdrawn at least for the same reasons as claims 1 and 16.

The Examiner rejects claims 19 and 20 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Flanders* (U.S. Patent No. 6,366,592). As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claims 19 and 20 depend from claim 16. Therefore, the Applicant respectfully requests that the rejection of claims 19 and 20 be withdrawn at least for the same reasons as claim 16.

The Examiner rejects claim 21 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Perry* (U.S. Patent Application Pub. US 20020001321 A1). As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claim 21 depends from claim 16. Therefore, the Applicant respectfully requests that the rejection of claim 21 be withdrawn at least for the same reasons as claim 16.

The Examiner rejects claims 4 and 23 under 35 U.S.C. § 103 as being unpatentable over *Ohshima* in view of *Munks* (U.S. Patent No. 6,289,028). As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claim 4 depends from claim 1 and claim 23 depends

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from claim 22. Therefore, the Applicant respectfully requests that the rejection of claims 4 and 23 be withdrawn at least for the same reasons as claims 1 and 22.

A. Rejection Under 35 U.S.C. §102(b)

The Examiner rejects claims 14, 15, 22, 24, and 25 under 35 U.S.C. § 102(b) as being anticipated by *Ohshima*. Because the Examiner has not established that *Ohshima* teaches each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

Ohshima is discussed above.

In direct contrast to *Ohshima*, claims 14 and 15 currently recite “a first photosensitive area supported by a substrate; [and] a second photosensitive area supported by the substrate and located adjacent to the first photosensitive area....” Since the Examiner has not established that *Ohshima* teaches the device recited in claims 14 and 15, Applicants respectfully request that the rejection of claims 14 and 15 under 35 U.S.C. § 102(b) be withdrawn.

Claim 22 recites the element “determining a power of the light emitted by the laser diode from a sum of the detection response of the first photosensitive area and the detection response of the second photosensitive area....” As conceded by the Examiner on page 6, lines 14-17 of the Office Action, *Ohshima* does not teach “the power of the light emitted by the laser diode being determined from a sum of the detection response of the first photosensitive area and the detection response of the second photosensitive area.” Thus, claim 22 is not anticipated by *Ohshima*. Claims 24 and 25 depend from claim 22 and include each element of claim 22. Since *Ohshima* does not teach the device set forth in claims 22, 24, and 25, Applicants respectfully request that the rejection of claims 22, 24, and 25 under 35 U.S.C. § 102(b) be withdrawn.

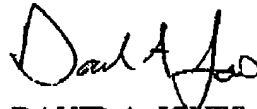
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CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 20 day of March, 2006.

Respectfully submitted,



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